

REMARKS

Applicant has carefully studied the Office Action of March 11, 2004 and offers the following remarks to accompany the above amendments.

Applicant herein rewrites claims 8, 20, 28, and 40 in independent form, thereby placing these claims in a condition for allowance. Applicant further amends claims 9, 10, 29, 30, 41, and 42 to depend from 8, 28, and 40, thereby placing those claims in condition for allowance. Applicant encloses a credit card form in the amount of \$344.00 reflecting the four new independent claims.

Claims 8, 20, 28, and 40 were objected to for an informality relating to "the serving switch" in lines 7 and 9. These claims have been amended for clarification, and Applicant requests withdrawal of the objection to these claims at this time.

Several other amendments have been made to the claims which are stylistic and do not change the scope of the claims. Specifically, the reference characters "a)", "b)" etc. have been deleted from several claims and the phrases "the steps of" and "the step of" have been deleted from the method claims. No new matter is added by these amendments, but the claims are stylistically improved.

Claims 1-7, 13-19, 21-27, 33-38, 45, and 47 were rejected under 35 U.S.C. § 103 as being unpatentable over Lu et al. (hereinafter "Lu") in view of Baldwin et al. (hereinafter "Baldwin"). Applicant respectfully traverses. Initially, when the Patent Office propounds an obviousness rejection over a combination of references, first, the Patent Office must articulate a motivation to combine the references, and second, the Patent Office must support the motivation with actual evidence. *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999). If the Patent Office fails to provide the actual evidence, then the Patent Office cannot combine the references. Once the combination is made, to establish *prima facie* obviousness, the Patent Office must still show where in the combination each and every element is located. MPEP § 2143.03. If the Patent Office cannot establish *prima facie* obviousness, the claims are allowable.

Applicant initially traverses the combination of Lu and Baldwin. The Patent Office opines that it would be obvious to combine Lu and Baldwin "to have a packet network in the invention of Lu in order to interconnect a base station and a PSTN across large distances using a common and widely available backbone data network and to properly manage communications in the packet network among base stations performing handoff, respectively." (Office Action of

March 11, 2004, page 3, lines 6-10). Applicant respectfully notes that the Office Action does not provide the actual evidence that the Federal Circuit mandated the Patent Office provide to support the motivation to combine the references. Since the Patent Office has not provided the requisite actual evidence, the combination is improper and the references are considered individually. The Patent Office admits that Lu does not show all the claim elements, so Lu individually cannot establish *prima facie* obviousness. Further, Baldwin does not teach the providing end office wireline telephony services to wireless subscribers and thus cannot establish *prima facie* obviousness. Since the references cannot be combined and the references individually do not establish obviousness, the claims are allowable. Applicant requests withdrawal of the § 103 rejection to claims 1-7, 13-19, 21-27, 33-38, 45, and 47 at this time.

Even if the combination is proper (a point which Applicant does not concede), Applicant further traverses the rejection on the basis that the Patent Office has only identified the first mapping step (i.e., mapping a subscriber's wireless telephony protocol to a packet data network protocol). The Patent Office has not shown in the references the mapping of the packet data network protocol to an end office protocol. While Baldwin does show a wireless to packet mapping through AAL-2, there is no indication that there is a packet to end office mapping. At best, Baldwin teaches a packet to vocoder mapping. Packet to vocoder mapping is not the same thing as the recited packet to end office protocol mapping. Thus, since Lu admittedly does not teach or suggest this element, and Baldwin does not teach or suggest this element, the combination of Lu and Baldwin cannot teach or suggest this element, and the Patent Office has not established obviousness, and the claims are allowable.

Claims 11, 12, 31, 32, 43, and 44 were rejected under 35 U.S.C. § 103 as being unpatentable over Lu in view of Baldwin and further in view of Focarile. Applicant respectfully traverses. The standard for determining obviousness is set forth above.

Applicant notes that the Patent Office still has not provided the requisite actual evidence to support the combination of Lu and Baldwin. Without such evidence the combination of the three references is improper and the references must be considered individually. As explained above and in the previous Responses, the references individually do not teach or suggest all the elements and do not establish obviousness.

Applicant further notes that Focarile does not teach or suggest the second mapping step, which is also missing from the combination of Lu and Baldwin. While the Patent Office opines

that Focarile discloses a wireless network connected to an end office (item 46) through a packet network as in Figure 1 of Focarile (see Office Action of September 8, 2003, page 2), Applicant traverses this assertion. Item 46 of Focarile is a PSTN, not an end office. As such, Focarile may show a packet to PSTN mapping, but does not necessarily show a packet to end office protocol mapping as recited in the claims. Absent evidence of a packet to end office protocol mapping, the reference individually, or in combination with the other references, does not teach or suggest the claim element and the claims are allowable.

Applicant requests reconsideration of the rejection in light of the amendments and remarks presented herein. The references are not properly combinable and/or do not teach or suggest all the claim elements. Applicant earnestly solicits claim allowance at the Examiner's earliest convenience.

Respectfully submitted,

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